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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,296	06/20/2001	Atsushi Shimizu	15115/003001	2665

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/885,296

Applicant(s)

SHIMIZU, ATSUSHI

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 12-19 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-11, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Claims 1-5, 9-11, 20 and 21 in Paper No. 13 is acknowledged. The traversal is on the ground(s) that separate status in the art has not been established, and that searching the claims together would not place any serious burden on the Examiner. This is not found persuasive because the examiner clearly explained how each Group (I, II, and II) contained a unique inventive concept, and would thus require a separate field of search for each group.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the

claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. If the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

4. Claims 1 and 2 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility. Specifically:
5. Independent Claims 1 and 2 appear to be describing a method that is attempting to sell a direction setting technique for growing personnel. Thus, this process does not include a

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distinguishable apparatus and would appear to be an attempt to patent an abstract idea not a “tangible” process and, therefore, non-statutory subject matter. 35 U.S.C. § 101 states that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” The present claims clearly are not directed to machines, manufactures, or compositions of matter. Accordingly, we must determine if the claimed subject matter falls into the statutory category of processes.

6. The Supreme Court in *Diamond v. Diehr*, 450 U.S. 175, 184, 209 USPQ 1, 6 (1981), explained:

In defining the nature of a patentable process, the court stated:  
That a process may be patentable, irrespective of the particular form of instrumentalities used, cannot be disputed. \*\*\* A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence. *Cochrane v. Denner*, 94 U.S. 780, 787-788 (1876).

7. The court further referenced a definition of “process” given in *Corning v. Burden*, 15 How. 252, 267-268 (1853) wherein the Court stated:

The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by a chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations, are called processes.... It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

8. The Court, thus, has defined a “statutory process” as requiring treatment of materials to produce a particular result, wherein such treatment transforms and reduces the subject matter to a different state or thing. In modern day language, the process must contain a form of

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computer automation, wherein the computer performs a piece of the process without direct human intervention.

9. As per independent Claims 1 and 2, the claimed methods fail to meet the court's definition of statutory process. Specifically, in the claimed methods of growing personnel direction setting, for there is no treatment of materials such that the subject matter is transformed and reduced to a different state. There is no computer automation; there is purely human intervention. Accordingly, the claimed methods are merely abstract ideas, and not statutory processes.
10. It is noted that the claims are directed to a business method, which is no longer an exception to statutory subject matter. However, merely labeling the method "a business method" does not magically transform it into a statutory process.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-5, 9-11, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Bechet et al. (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).
13. As per independent Claim 1, Bechet discloses a method of setting a direction of growing a personnel which is a method of setting a direction of growing a personnel necessary for

forming a plan of fostering the personnel in an organization, said method comprising the steps of: receiving information with regard to a mission of the organization and thereafter deducing a capability necessary for the organization by using the information; receiving information with regard to a capability of the respective personnel in the organization and thereafter deducing a capability held by the organization by using the information; and sampling an excess or deficient state of the capability in the organization by comparing a necessary amount of the capability with a capability amount held by the organization for a respective kind of the capability necessary for the organization and thereafter individually setting the direction of growing the respective personnel from the information with regard to the capability of the respective personnel based on a result of sampling thereof (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

14. As per independent Claim 2, Bechet discloses a method of setting a direction of growing a personnel which is a method of setting a direction of growing a personnel necessary for forming a plan of fostering the personnel in an organization, said method comprising the steps of: receiving information with regard to a current mission of the organization and a mission having a possibility of being given to the organization in the future and thereafter deducing capabilities necessary for the organization at present and in the future by using the information; receiving information with regard to a capability and a future image of the respective personnel in the organization and thereafter deducing a capability held by the organization and a capability having a possibility of being held by the organization in the future by using the information; and sampling excess or deficient states of the capabilities in

the organization by comparing necessary amounts of capabilities with a capability amount held by the organization and a capability amount having a possibility of being held by the organization in the future for respective kinds of the capabilities necessary for the organization at present and in the future and thereafter individually setting the direction of growing the respective personnel from the information with regard to the capability and the future image of the respective personnel based on a result of sampling thereof (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

15. As per independent Claim 3, Bechet discloses a method of selecting a supplementary capability which is a method of selecting a capability supplemented to an organization, said method comprising the steps of: receiving information with regard to a mission of the organization and thereafter deducing a capability necessary for the organization by using the information; receiving information with regard to a capability of a respective personnel in the organization and thereafter deducing a capability held by the organization by using the information; sampling an excess or deficient state of the capability in the organization by comparing a necessary amount of the capability with a capability amount held by the organization for respective kind of the capability necessary for the organization; and sampling data in accordance with a deficient state of the capability in the organization from a data base registered with a supplementary personnel having a predetermined capability or a business service executed by the capability (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).



16. As per independent Claim 4, Bechet discloses a method of selecting a supplementary capability which is a method of selecting a capability supplemented to an organization, said method comprising the steps of: receiving information with regard to a current mission of the organization and a mission having a possibility of being given to the organization in the future and thereafter deducing capabilities necessary for the organization at present and in the future by using the information; receiving information with regard to a capability and a future image of a respective personnel in the organization and thereafter deducing a capability held by the organization at present and a capability having a possibility of being held by the organization in the future by using the information; sampling excess or deficient states of the capabilities in the organization by comparing necessary amounts of the capabilities with a capability amount held by the organization and a capability amount having a possibility of being held by the organization in the future for respective kinds of the capabilities necessary for the organization at present or in the future and thereafter individually setting a direction of growing the respective personnel from the information with regard to the capability and the future image with regard to the respective personnel based on a result of sampling thereof; and forming and outputting a fostering plan including information indicating the direction of growing the respective personnel and sampling data with regard to a capability in accordance with a deficient state of the capability in the organization at present and a capability deficient during a time period until the respective personnel in the organization grows in line with the set direction of growing the respective personnel from a data base registered with a supplementary personnel having a predetermined capability or a business

service executed by the capability (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

17. As per Claim 5, Bechet discloses wherein after elapse of a predetermined time period from outputting the plan of fostering the personnel, a degree of promoting the capability held by the organization is sampled by using information with regard to the capability of the respective personnel at the time point and a reward sum charged to the organization is determined in accordance with the degree of promoting the capability (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).
18. As per independent Claim 9, Bechet discloses a system of forming a personnel fostering plan which is a system of forming a personnel fostering plan of a personnel in an organization, said method comprising: information inputting means for receiving information with regard to a mission of the organization and information with regard to a capability of a respective personnel belonging to the organization; necessary capability acquiring means for deducing a capability necessary for the organization for the mission by using the input information with regard to the mission of the organization; individual capability acquiring means for deducing the capability held by the respective personnel by using the input information with regard to the respective personnel; capability amount accumulating means for accumulating a capability amount held by the respective personnel with regard to the capability necessary for the organization for respective kind of the capability; sampling means for sampling an excess or deficient state of the capability in the organization by comparing a result of accumulating the capability amount provided by the capability amount accumulating means

with a necessary amount of the capability necessary for the organization; growing direction setting means for setting a direction of growing the respective personnel from acquired information by the individual capability acquiring means based on the excess or deficient state of the capability sampled by the sampling means; and plan forming means for forming a fostering plan indicating the direction of growing the respective personnel set by the growing direction setting means for the respective personnel (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

19. As per independent Claim 10, Bechet discloses a system of forming a personnel fostering plan which is a system of forming a personnel fostering plan of a personnel in an organization, said system comprising: information inputting means for receiving information with regard to a current mission of the organization and a mission having a possibility of being given to the organization in the future and information with regard to a capability and a future image of a respective personnel belonging to the organization; necessary capability acquiring means for deducing capabilities necessary for the organization at present and in the future for the missions by using the input information with regard to the missions of the organization at present and in the future; individual capability acquiring means for deducing a capability held by the respective personnel at present and a capability having a possibility of being held by the respective personnel in the future by using the input information with regard to the respective personnel; capability amount accumulating means for accumulating a capability amount held by the respective personnel at present and a capability amount having a possibility of being held thereby in the future for respective kinds of the capabilities

with regard to the capabilities necessary for the organization at present and in the future; sampling means for sampling excess and deficient states of the capabilities in the organization by comparing results of accumulating the capability amounts at present and in the future provided by the capability amount accumulating means with necessary amounts of the capabilities necessary for the organization at present and in the future; growing direction setting means for setting a direction of growing the respective personnel from acquired information by the individual capability acquiring means based on the excess or deficient states of the capabilities sampled by the sampling means; and plan forming means for forming a fostering plan indicating the direction of growing the respective personnel set by the growing direction setting means for the respective personnel (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

20. As per Claim 11, Bechet discloses information outputting means for outputting the plan of fostering the personnel formed by the plan forming means to outside (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

21. As per independent Claim 20, Bechet discloses an information transmitting medium which is an information transmitting medium written with information constituting an object by at least either one of an organization and a respective personnel in the organization by a computer system: wherein in the computer system, after sampling an excess or deficient state of a capability of the organization with regard to a capability necessary for a mission of the organization, a direction of growing the respective personnel is set from information with

regard to a capability of the respective personnel based on a result of sampling thereof and said information transmitting medium is constituted by being written with a personal fostering plan formed by using the direction of growing the respective personnel (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

22. As per independent Claim 21, Bechet discloses an information transmitting medium written with information constituting an object by an organization by a computer system: wherein in the computer system, after sampling an excess or deficient state of a capability of the organization with regard to a capability necessary for a mission of the organization, a direction of growing the respective personnel is set from information with regard to a capability of the respective personnel based on a result of sampling thereof, a supplementary personnel in accordance with a capability deficient in the organization is sampled from a data base and said information transmitting medium is constituted by being written with a personnel fostering plan formed by using the direction of growing the respective personnel and information for introducing the supplementary personnel (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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24. The following US patent is cited to show the best patented domestic prior art found by the examiner:

**U.S. Pat. No. 5,416,694 to Parrish et al.**

Parrish discloses a computer system and a method for a computer-based data integration and management processing system and a method for workforce planning and occupational readjustment.

25. The following foreign patent is cited to show the best foreign prior art found by the examiner:

**PCT No. WO 200077665 A2 to O'Keefe**

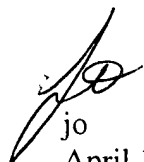
O'Keefe discloses an automatic staffing allocation method in a health care environment, which involves estimating workload units of staffing needed to care for people, by applying a model to view factor information associated with the people.


26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

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28. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

  
jo  
April 15, 2003

  
**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**